UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHEN BUSWELL, RIO T. RIVAS,
MEHRGAN KHAVARI, PAUL TEMPLIN,
MARK H. MACKENZIE and CONRAD JENSSEN

Appeal 2006-2433
Application 10/061,492
Technology Center 1700

Decided: August 30, 2006

Before WARREN, KRATZ, and GAUDETTE, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

REMAND TO THE EXAMINER

We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 CFR §41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

The record shows that in the final rejection mailed August 5, 2004, the Examiner set forth seven grounds of rejection, all under 35 U.S.C.

§ 103(a). The *sole* ground of rejection applied to independent claim 43, which had no claims dependent thereon at that time, involved Allen in view of Brouillette (final rejection 4-8). This ground of rejection was also applied to independent claims 1, 13, 24 and 41, and claims 2 through 7, 10 and 11, dependent on claim 1, claims 14 through 19 and 22, dependent on claim 13, and claims 25 and 31 dependent on claim 24. In the remaining grounds, Brouillette alone was applied to independent claims 24 and 41 and claim 25, dependent on claim 24; Allen in view of Brouillette further in view of Pollard was applied to claim 21, dependent on claim 13;Allen in view of Brouillette further in view of Murthy was applied to claims 9, 20 and 26, dependent on claims 1, 13 and 24, respectively; Allen in view of Brouillette further in view of Murthy and further in view of Wolf was applied to claim 30, dependent on claim 24, Allen in view of Brouillette further in view of Michaelis was applied to claims 27 through 29, dependent on claim 24, independent claim 33 and claims 34 through 37 dependent thereon; and Allen in view of Brouillette further in view of Michaelis and further in view of Pollard was applied to claims 38 and 39, dependent on claim 33 (*id.* 3-4 and 8-12).

In the amendment after the final action filed October 5, 2004, Appellants cancelled all pending claims except independent claim 43 and introduced new claims 46 through 48, all dependent on claim 43, without further amending claim 43 (amendment after final rejection 1-4). Appellants argued the ground of rejection based on Allen in view of Brouillette applied to the group of claims including claim 43 in the final

rejection, and applied the same arguments to claims 46 through 48 (amendment after final rejection 4-7).

In the advisory action mailed November 3, 2004, the Examiner entered the amendment after final rejection and addressed Appellants' arguments with respect to claims 43 and 46 through 48 based on Allen in view of Brouillette (advisory action 2-3). No other reference or ground of rejection is referred to in the advisory action.

In the Brief filed November 5, 2005, under the heading "(6) Grounds of Rejection to be Reviewed on Appeal," Appellants state only that "Claims 43 and 46-48 stand rejected under § 103 as being unpatentable over" Allen in view of Brouillette, and under the heading "(7) Argument," argue only this ground of rejection (Br. 5).

In the Answer mailed November 30, 2005,[1] the Examiner states that "[t]he appellant's [*sic*] statement of the ground of rejection to be reviewed on appeal is correct" (Answer 2). However, the Examiner advances the following grounds of rejection in the Answer: claims 43, 46 and 47 under 35 U.S.C. § 103(a) over Allen in view of Brouillette; claim 48 under 35 U.S.C. § 103(a) over Allen in view of Brouillette further in view of Pollard Murthy; and claim 48 under 35 U.S.C. § 103(a) over Allen in view of Brouillette further in view of Murthy (Answer 3-5).

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[1] The Answer mailed November 30, 2005 is apparently a Supplemental Answer superceding the first Answer mailed February 15, 2005, as we find no communication vacating the first Answer as ordered in the Order Returning the Undocketed Appeal to Examiner entered by the Board on October 27, 2005.

We find no basis in the record on which Appellants could have reasonably foreseen the grounds of rejection applied to claim 48 in the Answer. Indeed, the Examiner did not point out such grounds of rejection in the advisory action. See MPEP § 1207.03, III. Situations That Are Not Considered As New Grounds of Rejection (8th ed., Rev. 3, August 2005). Furthermore, the Examiner also did not point out the additional grounds of rejection in the Answer by finding that Appellants' statement of the grounds of rejection to be reviewed on appeal was incorrect and by designating the grounds as new grounds of rejection. See MPEP §§ 1207.02 and 1207.03, I. Requirements For A New Ground Of Rejection (8th ed., Rev. 3, August 2005).

Accordingly, the issues in this appeal have been incompletely prosecuted and briefed, and thus, the record is incomplete for purposes of appeal. Therefore, the Examiner is required to take appropriate action consistent with current examining practice and procedure to properly bring the grounds of rejection of appealed claim 48 to the attention of Appellants, and complete the prosecution of these grounds of rejection with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, if the Examiner submits a Supplemental Answer to the Board in response to this remand, "the appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 CFR §41.50(a)(2) (2005), "in order to avoid *sua sponte* dismissal of the appeal as

to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action. It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See* MPEP § 708.01(D) (8th ed., Rev. 3, August 2005).

REMANDED

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